

## **REMARKS**

### **Status of the Claims**

Claims 1-11 are pending in this application. Claims 1 and 5 are independent. Claims 1 and 5 have been amended for better clarity.

Reconsideration of this application is respectfully requested.

### **Request For Review By Supervisory Primary Examiner Pursuant To MPEP 707.02**

Section 707.02 of the MPEP provides, in pertinent part, that:

The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution (emphasis added).

Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort should be made to terminate its prosecution. In order to accomplish this result, the application is to be considered "special" by the examiner (emphasis added).

The present Office Action is the FIFTH Office Action to issue in this application that has been appealed and subject to the Action of February 17, 2011 after the incurring the expense of preparing and filing an appeal brief. This application has also been pending for over five years. Thus, close review by the Supervisory Patent Examiner is requested under MPEP § 707.02 as noted above.

As fully discussed below, the Examiner has erred and unnecessarily delayed the prosecution process by failing to comply with 35 U.S.C. § 132, 37 C.F.R. § 1.104 (c)(2), and the below-noted controlling court precedent.

It is therefore respectfully requested that this application be treated as special (as also required by MPEP 707.02), that the SPE become personally involved in the prosecution of the application to the extent required by MPEP 707.02 to insure proper adherence to the statute, the case law precedent, the Rules and the MPEP so that Applicants are not further burdened with yet another Office Action that is out of compliance with these authorities.

In order to demonstrate that the application has been carefully studied by the SPE under MPEP § 707.02, the SPE is respectfully requested to provide a statement confirming this to be the case with any subsequent Actions issued in this application.

### **Rejections under 35 U.S.C. § 103**

#### **A. Claims 1-8 and 10**

Claims 1-8 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Onoe et al. (U.S. Patent Application Publication No. 2005/0163130, hereinafter “Onoe”) in view of Enns et al. (U.S. Patent Application Publication No. 2006/0098669, hereinafter “Enns”). This rejection is traversed.

The outstanding Action begins the analysis of independent claim 1 by asserting that “Onoe et al. discloses a transmission device (transmitter for performing packet communication, ¶ [0032], page 1, lines 2-5).” However, ¶ [0032] present nothing but a general statement that the invention includes “a transmitter, a communication system, and a communication method of the same.” The noted disclosure of page 1, lines 2-5 (assuming line 1 is “1. Field of the Invention”) is also nothing more than a catalogue of these same general parts in terms of noting that the Onoe invention includes “a transmitter for performing packet communication in a packet network, a communication system, and a communication method of the same,” with absolutely no disclosure of the arrangement of any units that together will form the merely noted “transmitter.”

However, merely designating general statements that broadly indicate that a “transmitter” is part of the invention of Onoe clearly is not the required indication as to the particular transmitter of the disclosure of Onoe that is considered to be applicable. This is a denial the duty imposed on the PTO by 35 U.S.C. § 132, *see Chester v. Miller*, 906 F.2d 174, 1578 (Fed. Cir. 1990), stating that “35 U.S.C. 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”

Not only does such mere designation of general statements not satisfy 35 U.S.C. § 132, it violates 37 C.F.R. § 1.104 (c)(2) that requires “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.”

Accordingly, the outstanding Action clearly violates 35 U.S.C. § 132 and 37 C.F.R. § 1.104 (c)(2) as to not specifically identifying which elements are relied upon to correspond to the transmission device of independent claims 1 and 5 that has to itself include as a part thereof the recited elements of a classification unit functioning as claimed, a determination unit functioning as claimed, and a request unit functioning as claimed.

The outstanding Action then suggests that “the transmission packets generated by the process” mentioned in ¶ [0086] (as being “classified in packets to be bandwidth guaranteed”) can be interpreted to be the claimed “classification unit classifying a packet of data to be transmitted according to each packet header.” Clearly the teaching of ¶ [0086] is only a general statement of the operation of the first embodiment that starts with ¶ [0072] and ends with ¶ [0096]. Thus, while ¶ [0086] mentions that “the transmission packets generated by the process are classified in packets to be bandwidth guaranteed,” the nature of how this classification into packets to be bandwidth guaranteed” is accomplished is not presented in ¶ [0086]. Once again the outstanding Action attempts to take a broad statement appearing in one isolated paragraph out of context in a further clear violation of the above-noted authorities.

Further in this regard, where is the teaching that the relied upon suggestion of classifying “in packets to be bandwidth guaranteed” is done in the manner specified by independent claims 1 and 5 as to “classifying a packet of data to be transmitted according to each packet header?” It is well-established that “[w]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference,” see *In re Rijckaert*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

With further regard to the “determination unit” that must also be part of the transmission device of independent claims 1 and 5, the outstanding Action clearly errs by apparently suggesting that this “determination unit” can be somehow be reasonably interpreted to be a “prior art” vaguely referenced “transmitter” described in ¶ [0015] somehow combined with the “prior art” FIG. 4B “packet header in the IPv6 of the TCP protocol” noted at page 2, lines 1-2. What is missing is any explanation at all for modifying the apparently relied upon “transmitter” of the invention of Onoe by including in it a prior art “transmitter” described in ¶ [0015] that describes the “prior art,” not the vaguely referenced “transmitter” of ¶ [0032], page 1, lines 2-5, of Onoe. In this regard, it is well established that the PTO may not take completely unrelated

reference statements out of context and treat them as if they were part of a combination that is not described in the reference. *See In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) as follows:

While the test for establishing an implicit teaching, motivation, or suggestion is what the combination of these two statements of [the reference relied upon] would have suggested to those of ordinary skill in the art, the two statements cannot be viewed in the abstract. Rather, they must be considered in the context of the teaching of the entire reference. Further, a rejection cannot be predicated on the mere identification in [the reference relied upon] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

In this last regard, there appears to be no reasonable basis to assert that the skilled artisan would not understand that ¶ [0015] relates to a description of what was done in the “prior art,” not what is done relative to the unidentified transmitter of the Onoe invention. There is further no hint that the Onoe invention performs the outstanding Action suggested addition of a header using a “transmitter side host” as was done by the “prior art” that is being very generally described by ¶ [0015]. Similarly, page 2 lines 1-2 describe “prior art” FIG. 4B as showing a packet header in the IPv6 of the TCP protocol,” not a “transmitter” where such a header is added to a packet and then transmitted by this transmitter.

The further statement at page 3 of the outstanding Action that notes the claim requirement that the determination unit must organize “a set of packets having the same packet header as a packet group according to a classified result by said classification unit” is a further clear violation of the above-noted requirements of 35 U.S.C. § 132, 37 C.F.R. § 1.104 (c)(2), and the above-noted *Kotzab* decision. In this respect, the teachings of ¶ [0015] relate to a description of what was done in the “prior art” using a “transmitter side host” not what is done relative to the unidentified transmitter of the Onoe invention, and certainly not as to the teachings of ¶ [0086] that is relied upon to somehow teach the “classification unit.” In this last regard, the teachings of ¶ [0086] relate to the operation of the first embodiment that is disclosed to have “the process A at the node 150 serving as the transmitter” as noted specifically in ¶ [0087], not the addition of headers to packets by a transmission side host as in ¶ [0015].

Furthermore, it is not clear whether the indication of “page 2, 6, lines 1-3, 1-3” at page 3 of the outstanding Action includes a typographical error or if the “prior art teachings” of page 2, lines 1-3 (as to prior art FIG. 4B) are being noted with the disjointed language taken from lines 1-3 of page 6 (“address and port number connected to the socket and the designated peer IP address and port number. [0085] FIG. 14 shows a case where packet transfer is”).

In addition, whatever is taught at relied upon ¶ [0015] and page 2, lines 5-11, also noted at page 3 of the outstanding Action, relates to what was done in the “prior art,” not what is done relative to the unidentified transmitter of the Onoe invention or as to the still unidentified elements of the Onoe invention that can be even remotely asserted to be a determination unit in a transmission device of the Onoe invention somehow taught by ¶ [0086] of Onoe. Furthermore, there is no explanation as to how the page 3 relied upon ¶ [0015] and page 2, lines 5-11 of the Onoe description of the “prior art” can be said to reasonably teach the claimed determining whether to transmit a packet group “with a bandwidth guaranteed according to a bit rate of the packet group” relative to teachings only applicable to transmitting just individual prior art packets.

As to the request unit recited to also be a part of the transmission device, page 3 of the outstanding Action asserts that ¶ [0024] and page 2, lines 2-4 that are directed to the “prior art,” not the invention of ¶ [0086] of Onoe, are in some way relevant to a transmission device operating in accordance with ¶ [0086].

In addition, ¶ [0024] simply describes bandwidth guaranteed transfer in a “prior art” system with “prior art” routers” and a transmission node that is clearly a transmission device, not the claimed request unit that must request “a bandwidth control device to reserve a bandwidth for a packet group” (emphasis added). The outstanding Action makes no attempt to show how ¶ [0024] and page 2, lines 2-4 of Onoe can be reasonably said to teach the claimed “bandwidth control device,” much less one that is taught to reserve a bandwidth for a packet group” (emphasis added).

As noted above, independent claim 5 is like independent claim 1 in requiring a classification unit, a determination unit and a request unit and pages 7-8 of the outstanding Action essentially repeats much of the inadequate and disjointed reasoning offered as to these limitations as was offered at page 3 relative to claim 1 and adds a further inadequate and

disjointed rationale of the first full paragraph on page 8 as to the claim 5 further recited calculations.

Further in this regard, independent claim 5 adds specific requirements as to the operation of the determination unit that must calculate “a buffer capacity required when a packet group is to be transmitted in a specific bandwidth” by “performing the calculation with the bandwidth changed, deriving a relationship between a required bandwidth and a required buffer capacity, and determining whether the packet group is a packet group to be transmitted with a bandwidth guaranteed from said relationship.”

Even if it can be said that ¶ [0015] and ¶ [0018] of Onoe suggest a buffer for each queue, and ¶ [0011] of Onoe teaches that “packets indicated by bandwidth guarantee of data 100 and 150 are represented by numerals proportional to the guaranteed bandwidth” as urged in the first full paragraph on page 8 of the outstanding Action, there is absolutely no reasonable teaching or suggestion to be found in these disjointed teachings pointing to the above-noted independent claim 5 determination unit determining the above-noted “buffer capacity required when a packet group is to be transmitted in a specific bandwidth” in the manner specified (by “performing the calculation with the bandwidth changed, deriving a relationship between a required bandwidth and a required buffer capacity, and determining whether the packet group is a packet group to be transmitted with a bandwidth guaranteed from said relationship”).

Moreover, these paragraphs ([0011], [0015], and [0018]) all again relate to the “prior art” packet communication system, not the transmission device and packet transmission noted as to the embodiment that is discussed by relied upon ¶ [0086]. The above-noted *Kotzab* decision makes it clear that a rejection cannot be predicated on the mere identification in a single reference of “individual components of claimed limitations” absent “particular findings . . . as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” While many reasons might suggest a combination of reference teachings, the PTO must still present “some articulated reasoning with some rational underpinning” to support such a combination of reference teachings. See *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

Instead of the required reasons why the artisan would want to try to modify the embodiment associated with ¶ [0086] of Onoe by the “prior art” teachings of Onoe (in paragraphs [0011], [0015], and [0018]) and any explanation of the result of such modifications, the outstanding Action merely references paragraphs relating to these different embodiments as if they represented components shared by some overall combination, which is clearly not the case. As explained by the Board in *Ex parte Osmond*, 191 USPQ 334 (Bd. Pat. App. & Int. 1973), isolated disclosures having no teaching in the reference containing them that there is any interrelationship there between or reason to combine such isolated teachings into a single combination cannot be said to teach a claimed invention simply because these unconnected features all appear in one reference.

Just as there is no adequate rationale that discusses some reasonable basis that would have led the artisan to try to modify the embodiment associated with ¶ [0086] of Onoe by the “prior art” teachings of paragraphs [0011], [0015], and [0018], there is no reasonable explanation as to what would have led the artisan to try to modify something taught by Onoe that would permit it to operate to reserve bandwidth as taught by relied upon ¶ [0072] at page 8, lines 8-13 of Enns.

In this last regard, the relied upon Enns teaching is that “[g]uaranteed bandwidth reservation is provided through an application interface from the network operator's side, or the subscriber's side, and factors including the amount of bandwidth requested and inactivity time is utilized in reserving a given amount of bandwidth.” This teaching has no relevance to “**a bandwidth control device to reserve a bandwidth for a packet group**,” which is the subject matter claimed and which is also the subject matter not taught by Onoe. This subject matter has nothing to do with any “application interface from the network operator's side, or the subscriber's side” providing a bandwidth request as in Enns.

Besides failing to present “some articulated reasoning with some rational underpinning” to support modifying some unidentified part of Onoe by incorporating some unidentified “application interface from the network operator's side, or the subscriber's side,” the lack of the identification of the proposed reference modifications is a further clear error that violates PTO policy set forth by MPEP § 706.02(j). In this respect, this section requires that the examiner is to identify “the proposed modification of the applied reference(s) necessary to arrive at the claimed

subject matter” in order to support a rejection under 35 U.S.C. 103(a). As explained here, such an explanation is necessary because “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” See *In re Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1432-33 (Fed. Cir. 2002) and the requirement therein for “a full and reasoned explanation” as well as for an adequate finding of actual facts and an explanation of how these actual facts support the rejection.

Accordingly, reconsideration and withdrawal of the rejection of independent claims 1 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Onoe in view of Enns are respectfully requested.

Furthermore, as claims 2-4 and 10 depend directly or indirectly from independent claim 1 while claims 6-8 depend directly or indirectly from independent claim 5, these dependent claims are respectfully submitted to be improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over Onoe in view of Enns for at least the same reason as noted above as to parent independent claims 1 and 5.

Accordingly, reconsideration and withdrawal of the improper rejection of dependent claims 2-4, 6-8, and 10 under 35 U.S.C. § 103(a) as being unpatentable over Onoe in view of Enns is also respectfully requested.

#### **B. Claims 9 and 11**

Claims 9 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Onoe in view of Enns in further view of Rogers (U.S. Patent Application Publication No. 2001/0036181). This rejection is traversed.

Rogers is cited as to the subject matter added by claims 9 and 11 and does not cure the deficiencies noted above as to the reliance on Onoe in view of Enns with respect to parent independent claim 1. Accordingly, claims 9 and 11 patentably define over the applied references for at least the same reason that parent independent claim 1 does. Thus, reconsideration and withdrawal of this improper rejection of claims 9 and 11 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Onoe in view of Enns in further view of Rogers are respectfully requested.



**Conclusion**

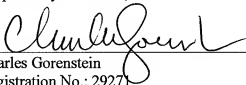
As all of the stated grounds of rejection have been properly traversed, it is respectfully requested that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr., Registration No. 40,440, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: January 27, 2012

Respectfully submitted,

By 

Charles Gorenstein

Registration No.: 29271

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, VA 22040-0747

703-205-8000